

Appl. No. : 10/608,598
Filed : June 27, 2003

REMARKS

Claim 32 has been added to cover a commercial embodiment and no new matter is added. Claims 1-24 and 32 are presently pending.

Rejection of Claims 1-2, 4, 6-11, 13-16, 19 and 22 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 1-2, 4, 6-11, 13-16, 19 and 22 as obvious over Yeh in view of Yasui and Shirono. According to the Examiner, Yeh discloses a grip formed of an elongated strip comprising an elastomer layer bonded to a felt layer, but fails to teach a powdered inorganic antimicrobial agent in an elastomer. Examiner further asserted that Yasui discloses an elastomer grip formed from synthetic resin and an antibacterial and antifungal material in the form of pellets of inorganic material of silver in porous silica-alumina or zeolite carrier for sporting equipment in the form of a fishing pole. It is also the Examiner's view that Shirono discloses an inorganic antimicrobial agent being a powder in the form of a metal being carried on zeolite.

Applicant respectfully disagrees with the Examiner's characterization of Shirono's inorganic antimicrobial agent being a powder. The antibacterial agent disclosed in Shirono is a colloidal solution of inorganic oxide having antibacterial characteristics (col. 2, lns. 2-3), and not a powder. Shirono points out numerous problems associated with powdery antibacterial compositions (col. 1, ln. 16-40), and explicitly states that its objective is to provide novel antibacterial substance which can solve the problems of antibacterial powdery composition, wherein the novel antibacterial substance is in the form of a colloidal solution (col. 1, ln. 66 – col. 2 ln. 3). Since Shirono teaches away from using powdered antibacterial agent with resins and rubbers, it is improper for the Examiner to combine Shirono with Yeh and Yasui to suggest that using powdered inorganic antibacterial agent with elastomer layer is obvious. In fact, Applicant's invention for the first time disclosed the unexpected and successful use of powdered inorganic antibacterial agent and is therefore nonobvious.

One of ordinary skill in the art would not combine the references of Yeh and Yasui because they are directed toward entirely different uses of grips made of elastomer. Yeh's grip is for improved moisture absorption of a sports racquet grip, while Yasui's grip provides

Appl. No. : 10/608,598
Filed : June 27, 2003

antibacterial property in fishing poles. Although Yeh's grips can be made using an elastomer layer, Yeh does not teach that it would be desirable or advantageous to incorporate agents having antibacterial or antifungal property into their elastomer layer for use in sport racquets. Furthermore, Yeh does not identify a problem to be solved in sport racquet grips, namely microbial infestation on grip materials. Therefore there is no motivation in Yeh to look to Yasui for its teaching related to the antimicrobial agent. Yasui does not teach that it would be desirable to use a thin layer of polymeric material having a longitudinal axis sized for wrapping helically about an elongated handle (see Yeh, Claim 1), and does not suggest that it may be advantageous to use the antibacterial agent in sports racquet grips. In addition, Yasui's grip is directly molded from melted (liquid) polymeric materials onto a cylinder fitted around the peripheral surface of the rod main body (col. 1, lns. 59-61), which is very different from Yeh's grip that is in a form of thin layer polymeric strip with a backing made of porous material (col. 2, lns. 48-50). Thus neither reference suggests or motivates the skilled practitioner to combine the teachings. Indeed, the Yeh and Yashi processes are so different from one another that combining these different teachings is not technically feasible.

Even if assuming *arguendo* that Yeh and Yasui are properly combinable (which they are not), the combination fails to teach or suggest all the claimed limitations. As the Examiner pointed out, Yasui teaches the use of an inorganic antibacterial material in the form of pellets with synthetic resin. Combining Yasui and Yeh would only suggest using a pellet containing inorganic antibacterial agent in forming elastomer grips for sports racquets. It is clear from Yasui that the pellet must be melted at high temperature with the synthetic resin to form the moldable liquid used to form the molded foam grips, which process is incompatible with Applicant's process of polymerizing elastomer-forming solution to form an elastomer layer bonded to a textile layer. Applicant's grip comprises powdered inorganic antimicrobial agent dispersed within an elastomer layer. The use of powdered inorganic agent is not taught or suggested by either Yasui or Yeh. In addition, Shirono further teaches away from using the powdered form; therefore the combination of Yeh, Yasui and Shirono does not teach or suggest all the claimed limitations. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 1-2, 4, 6-11, 13-16, 19 and 22 as obvious over Yeh in view of Yasui and Shirono.

Appl. No. : 10/608,598
Filed : June 27, 2003

Rejection of Claims 12, 17-18, 20-21 and 23-24 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 12, 17-18, 20-21 and 23-24 as obvious over Yeh in view of Yasui and Shirono, and further in view of Hayashi. Hayashi is said to disclose an inorganic antimicrobial of silver in a zeolite carrier being silver in a montmorillonite carrier. Applicant respectfully points out that Claims 12, 17-18, 20-21 and 23-24 are dependent on independent Claims 1, 16, 19 and 22, which are non-obvious over Yeh, Yasui and Shirono for all the reasons detailed above. The additional of montmorillonite cannot cure the defect in the Examiner's case of obviousness, since the combination of the references fail to render obvious a grip comprising an elastomer layer having a powdered inorganic antimicrobial agent dispersed therein. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 12, 17-18, 20-21 and 23-24.

Rejection of Claims 3 and 5 under 35 U.S.C. § 103(a)

The Examiner rejected Claims 3 and 5 as obvious over Yeh in view of Yasui and Shirono, and further in view of Huang. Because Claims 3 and 5 depend from independent Claim 1, which is patentable over Yeh in view of Yasui and Shirono for the reasons articulated above, the addition of Huang fails to render these claims unpatentable. Accordingly, Applicant respectfully requests withdrawal of the rejection of Claims 3 and 5.

Appl. No. : 10/608,598
Filed : June 27, 2003

CONCLUSION

In view of the above remarks, Applicant respectfully requests withdrawal of rejections on the claims and assert that the present application is in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: May 9, 2006

By: Mark R. Benedict
Mark R. Benedict
Registration No. 44,531
Attorney of Record
Customer No. 20,995
(949) 760-0404

2524563
041406